

- I. Claims 39-44, drawn to a vacuum chuck, classified in class 269, subclass 21.
- II. Claims 27-38, drawn to a method of producing first and second aspheric surfaces, in class 82, subclass 1.3.

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The Examiner argued that restriction between these groups of claims is required because:

Inventions of Group I and Group II *are related as process of making and product made*. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case *the method can be used to machine security devices and fashion ornaments*.

*Id.* (emphasis added).

In response to the restriction requirement, Applicant elects the Examiner's Group II, claims 27-38, for examination, with traverse.

Applicant respectfully submits that the Examiner's assertion that "Group I and Group II are related as process of making and product made" is based on a misreading of the claims of the present invention. Applicant submits that Groups I and II are in fact related as a process and an apparatus for its practice, Group II, Claims 27-38, being directed to a "method of producing first and second surfaces on a precision optical element"--a process --and Group I, Claims 39-44, being directed to a "vacuum chuck for holding a precision optical element, for single point machining of a second aspheric surface thereon"--an apparatus for practicing the process.

In any event, even if Groups I and II are considered as a process of making and product made, as alleged by the Examiner, under the standard set forth in MPEP § 806.05(f), Groups I and II are not distinct and not subject to restriction. The *vacuum chuck* of Group I could not be manufactured using the method of producing first and second surfaces *on a precision optical element* of Group II. Conversely, the method of producing first and second surfaces *on a precision optical element* of Group II, could not be used to manufacture the *vacuum chuck* of Group II.

As noted above, notwithstanding the Examiner's reliance on MPEP § 806.05(f), Applicant respectfully submits that the Examiner's Group I and II, in fact, relate to a restriction requirement between a process and apparatus for its practice. As such, the distinctness of Groups I and II should be judged under the standard set forth in MPEP § 806.05(e), Process and Apparatus for its Practice--Distinctness, which provides as follows:

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process.

(emphasis in original). The same section further notes that “[t]he burden is on the Examiner to provide reasonable examples that recite material differences.”

The process *claimed* in independent Claim 27 constitutes:

*A method of producing first and second aspheric surfaces on a precision optical element* having a radial dimension, comprising the steps of:

forming said first aspheric surface on said element;  
*forming on a vacuum chuck, a support surface* having a width in its radial direction less than 50% of said radial

dimension of said element, and having an aspheric form matching that of said first aspheric surface formed on said element; and  
*subsequently forming said second aspheric surface on said element while it is held with said first aspheric surface in said vacuum chuck.*

(emphasis added).

Similarly, the process *claimed* in independent Claim 34 constitutes:

*A method of producing first and second aspheric surfaces on a precision optical element, comprising the steps of:*  
*forming said first aspheric surface on said element;*  
*forming on a vacuum chuck, a support surface having an aspheric form matched to said first aspheric surface formed on said element, said support surface having a major portion removed; and*  
*subsequently machining said second aspheric surface on said element while it is held with said first aspheric surface in said vacuum chuck.*

(emphasis added).

On the other hand, the apparatus for its practice *claimed* in independent

Claim 39 constitutes:

*A vacuum chuck for holding a precision optical element having a first aspheric surface, for single point machining of a second aspheric surface thereon, said chuck having a support surface on which said first aspheric surface of said element is seated, said support surface having an aspheric form matching that of said first aspheric surface of said element, wherein a major portion of said support surface is removed.*

(emphasis added).

Applicant submits that, in the absence of the vacuum chuck of Claim 39, the processes of Claims 27 and 34, could not be practiced “by another materially different apparatus or by hand.” MPEP § 806.05(e). The process of Claims 27 and 34 requires the “*forming on a vacuum chuck, a support surface having an aspheric form matched to said*

first aspheric surface formed on said [precision optical] element” and “subsequently machining said second aspheric surface on said element *while it is held with said first aspheric surface in said vacuum chuck*” (emphasis added). Accordingly, Applicant respectfully submits that the Examiner’s Group I, Claims 39-44, and Group II, Claims 27-38, do not meet element (A) of the standard for distinctness set forth in MPEP § 806.05(e), and so restriction cannot be required on that basis.

Applicant further submits that the vacuum chuck of Claim 39 could not be used for anything other than the method of Claims 27 and 34 for “producing first and second aspheric surfaces on a precision optical element.” The apparatus for practice of this process *claimed* in Claim 39 requires a “*vacuum chuck for holding a precision optical element having a first aspheric surface, for single point machining of a second aspheric surface thereon,*” and a “support surface on which said first aspheric surface of said [precision optical] element is seated, *said support surface having an aspheric form matching that of said first aspheric surface of said [precision optical] element.*”

(emphasis added). Accordingly, Applicant respectfully submits that the Examiner’s Group I, Claims 39-44, and Group II, Claims 27-38, do not meet element (B) of the standard for distinctness set forth in MPEP § 806.05(e) and that restriction cannot be required on that basis.

Applicant further submits that the single example offered by the Examiner--the bare statement that the method of Claims 27-38 could be used to “machine security devices and fashion ornaments”--albeit given in the context of the Examiner’s improper reliance on MPEP § 806.05(f), Process of Making and Product Made--Distinctness, does not meet the burden on the Examiner “to provide reasonable examples